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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/638,063

Applicant(s)

TERASE, TAKAO

Examiner

Andrew J. Fischer

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-10, 12-15 and 18-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-10, 12-15 and 18-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. Applicant's amendment filed November 23, 2004 is acknowledged. Accordingly, claims 3-10 and 12- 15, and 18-33 remain pending.
2. All references in this Office Action to the capitalized versions of "Applicant" refers specifically the Applicant of record. References to lower case versions of "applicant" or "applicants" refers to any or all patent "applicants." Unless expressly noted otherwise, references to "Examiner" in this Office Action refers to the Examiner of record while reference to or use of the lower case version of "examiner" refers to examiner(s) generally.

Claim Rejections - 35 USC §112 2nd Paragraph

3. The following is a quotation of the 2nd paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 20, 26 are rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow.
 - a. In claim 20, it is unclear if Applicant is claiming the "Internet" or a subset of the Internet such as an "international communications network." It is the Examiner's factual termination that the Internet need not be international.
 - b. Regarding claim 26, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.
See MPEP §2173.05(d).

c. In claims 3, 28, and 30, it is unclear if the list of items is conjunctive or disjunctive. In other words, it is unclear if all items in the list are needed for anticipation/infringement¹ or just a single item in the list is needed for anticipation/infringement. *E.g.*, if all three items are needed for patentability during ex parte examination, then all three items will be needed for infringement. This interpretation makes the list *conjunctive*. Alternatively, if only one item from the list is needed for patentability during ex parte examination, then only one item from the list will be needed for infringement. Conversely the later interpretation makes the list *disjunctive*.

Claim Rejections - 35 USC §103

5. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-10, 12-15, 20-28, and 30-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over McHale, IV et. al. (U.S. 2002/0038165 A1) ("McHale") in view of Smith et. al. (U.S. 5,826,043) ("Smith"). McHale discloses a portable, table top terminal (102); a kitchen terminal (112); an accounting unit (math coprocessor within 104); a control unit (104); a terminal receptacle (computer chassis, or alternatively, the tabletop itself); the portable table top terminal

¹ Applicant is reminded of the axiom of "that which infringes if later, anticipates if earlier" *Polaroid Corp. v. Eastman Kodak Co.*, 789 F.2d 1556, 1573, 229 USPQ 561, 574 (Fed. Cir.1986) citing *Peters v. Active Mfg. Co.*, 129 U.S. 530,537 (1889).

Art Unit: 3627

is ready for use when placed on the terminal receptacle (inherent since not only is it ready for use when placed on the terminal receptacle, it is ready for use *prior to* being placed in or on the terminal receptacle); data is transmitted and received using radio communications between the portable table top terminal, the kitchen terminal, the accounting unit, and control unit (paragraph no. 0063); wherein information indicating cooked dishes is input on the kitchen terminal and transmitted to the portable terminal (touching the "item" icon in 0107); a worktable terminal (114) is configured to indicate a table to be served in response to the information representing the cooked dishes; a guide display is configured to indicate at least vacant tables (the seater station in 0086); a head office terminal is configured to transmit visual indications of new menus or commercials (108); a flat panel display (inherent within 124); the portable table top terminals and the kitchen terminal are configured to recognize an employee terminal operator name and a terminal identification number (inherent in the tabletop computer since it must recognize which table ordered the particular dish and thus the wait staff); the portable table top terminals and the kitchen terminal are configured to input a terminal employee name and a terminal time of input (wait staff name and time the dish was ordered); the portable table top terminal is configured to be used at a counter or counter seat (*e.g.* near a patron sitting at the bar); the portable table top terminal is configured to indicate an operational status (on or off); an Internet connection (0010); the table top terminal comprises a visual display (the monitor); a connection to a POS network (*e.g.* credit card network); configured to transmit sales data from a head office to update an existing menu (inherent within the network in Figure 1); the table top terminal is configured to display out of stock items (its configured to display virtually all items at least by description); an order status device (a subroutine with the main computer program running the system)

Art Unit: 3627

configured to indicate when ordered items are not available (*i.e.* out of stock); the kitchen terminal is configured to indicate a product-ready indication and transmit the indication to the portable table top terminal (touching the “item” icon in 0107); the terminal is configured to indicate material information (inherent since they can display practically any information in the system); an image input unit (the Internet) capable of creating a menu (*e.g.* Figure 9); an analysis unit (subroutine with operating software) configure to collect data; a communications device; the table top terminal is configured is configured to terminate an order (cancel or turn the terminal off); the table top terminal is configured specify a time for service (because times are input into the system, an approximate time for service can be calculated); the working status of employees is continuously monitored (inherent in the manager visually observing the employees) and a work command is issued to idle employees (inherent when the manager states, “get to work!” or “please check on table 5, they need assistance”); and the portable table top terminal is configured to display a sum of ordered items (the total bill). McHale does not directly disclose a receptacle nor a number reading part.

Smith teaches a portable work unit (such as a laptop computer) with a number reading part (Interface 266) to be used within the receptacle. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the McHale combination as taught by Smith to include Smith’s idea of identifying the docking station with the computer. Such a modification would have allowed the identification of table stations which might ultimately provide for the identification of patrons as discussed in Kurland (U.S. 4,547,851).

Art Unit: 3627

7. Claim 18, as understood by the Examiner, is rejected under 35 U.S.C. §103(a) as being unpatentable over The McHale/Smith combination in further view of Todd (U.S. 6,072,393 B1). The McHale/Smith combination discloses as discussed above but does not directly disclose an alarm if not placed on a receptacle. Todd teaches using an alarm to alert appropriate persons if the computer is not placed on a recognized receptacle.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the McHale/Smith combination as taught by Todd to include Todd's alarm system. Such a modification would have helped deter theft and catch thieves in the act of absconding with a table top terminal.

8. Claim 19, as understood by the Examiner, is rejected under 35 U.S.C. §103(a) as being unpatentable over The McHale/Smith combination in further view of Duphorne (U.S. 6,212,265 B1). The McHale/Smith combination discloses as discussed above but does not directly disclose an email system. Duphorne teaches using an email system to receive food orders sent by a customer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the McHale/Smith combination as taught by Duphorne to include sending email between terminals. Such a modification would have allowed the customers in the McHale/Smith to communicate with other customers while awaiting their order. Such is the idea behind many Internet Cafes.

9. Claim 29, as understood by the Examiner, is rejected under 35 U.S.C. §103(a) as being unpatentable over the McHale/Smith combination in view of Kono (U.S. 6,229,694 B1). The McHale/Smith combination discloses as discussed above but does not directly disclose a device configured to verbally repeat contents of orders. Kono teaches a device configured to verbally

Art Unit: 3627

repeat information. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the McHale/Smith combination as taught by Kono to include a device configured to verbally repeat contents of orders. Such a modification would have helped visually impaired customers confirm their orders.

10. Under the broadest reasonable interpretation standard noted above and unless modified in this Office Action, the Examiner maintains his interpretations including the statements and/or definitions of claim limitations as noted in previous office actions. Those previous definitions are part of the administrative record and, in accordance with *In re Morris*, are provided simply as a factual source to support the Examiner's claim interpretations (and ultimately the Board of Patent Appeals and Interferences claim interpretations if necessary²) during ex parte examination.

11. For due process purposes, the Examiner again confirms that Applicant has decided not to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner relies on the following factual findings. First and as noted in the previous Office Action,³ the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only has Applicant not pointed to definitional statements in his specification or prosecution history, Applicant has also not

² See *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) (“[W]e hold that the Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for our review.”).

³ See the First Non Final Office Action mailed September 30, 2003, Paragraph No. 9; the First Final Office Action mailed January 14, 2004, Paragraph No. 18; and the Second Non Final Office Action mailed August 26, 2004, Paragraph No. 10.

Art Unit: 3627

pointed to a term or terms in a claim with which to draw in those statements⁴ with the required clarity, deliberateness, and precision.⁵ Third, after receiving express notice in the previous office actions of the Examiner's position that lexicography is not invoked,⁶ Applicant has not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (*i.e.* Applicant has not argued lexicography is invoked). Finally and to be sure of Applicant's intent, the Examiner also notes that Applicant has again declined the Examiner's express invitation⁷ to be his own lexicographer.⁸ Accordingly and for due process purposes, the Examiner maintains his position that for the remainder of the examination process (and unless expressly noted otherwise by the Examiner), the heavy

⁴ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁵ "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

⁶ See Note 2.

⁷ *Id.*

⁸ The Examiner's requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner's requirements were simply an express request for clarification of how Applicant intend his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed February 11, 2005).

Art Unit: 3627

presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their “broadest reasonable interpretation” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).⁹ The Examiner continues to rely heavily and extensively on this interpretation.¹⁰ Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

12. With respect to the pending claims, the Examiner respectfully reminds Applicant that: “A system is an apparatus.” *Ex parte Fressola* 27 USPQ2d 1608, 1611 (B.P.A.I. 1993)(citations omitted). Additionally, “[c]laims in apparatus form conventionally fall into the 35 U.S.C. §101 statutory category of a ‘machine.’” *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Therefore, it is the Examiner’s position that Applicant’s system claims are “product,” “apparatus,” or more specifically, “machine” claims.¹¹

13. In light of Applicant’s choice to pursue “machine” or “product” claims, Applicant is also reminded that functional recitations using the word “for,” “configured to,” or other functional terms (*e.g.* see claim 3 which recites “the portable table top terminal is configured to read the

⁹ See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) (“In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification”) (citations omitted); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc); and MPEP §§ 2111 and 2111.01.

¹⁰ See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]”

Art Unit: 3627

identification number of the terminal receptacle”) have been considered but are given little patentable weight¹² because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use in a product claim must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending. With reference to the example noted above, the Examiner suggests removing “configured to” and affirmatively recite the intended action: --the portable table top terminal reads the identification number of the terminal receptacle--.

Response to Arguments

14. Applicant’s arguments with respect to the claims on November 23, 2004 have been considered but are moot in view of the new grounds of rejection.

¹¹ Products may be either machines, manufactures, or compositions of matter. MPEP §2106 IV B. 2 (a).

¹² See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight.).

Conclusion

15. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

16. References considered pertinent to Applicant's disclosure are listed on form PTO-892.

17. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8th Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 3627

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

19. Because this application is now final, Applicant is reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

20. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his "REMARKS/ARGUMENTS" (beginning on page 9 of his response filed

Art Unit: 3627

November 23, 2004) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,¹³ the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in his next properly filed response. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.



Andrew J. Fischer
Primary Examiner
Art Unit 3627

AJF
February 11, 2005

¹³ *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.